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Attorney's Docket No. 11087-004001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

BAUM et al.

Application No.: 09/436,704

Filed: 11/9/1999

For: Distributing Images to Multiple  
Recipients

Examiner: Justin Foster

Art Unit: 2624

**APPELLANT'S SUPPLEMENTAL  
BRIEF ON APPEAL**

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Sir:

This Supplemental Appeal Brief is presented in support of the Request for Reinstatement of the Appeal in response to the Office Action mailed 8/26/2004 in response to the Appeal Brief filed on May 7, 2004 from the final rejection of Claims 1-155 of the above-identified application, as set forth in the Final Office Action mailed October 28, 2003.

Please deduct the requisite small entity fee, pursuant to 37 C.F.R. § 1.17(c), to Deposit Account 501861, and deduct any additional fees or credit any excess fees associated with the Appeal Brief to such deposit account. An original and two copies of the Brief are enclosed herewith. Appendix A, attached hereto, contains a copy of all claims pending in this case.

#### REAL PARTY OF INTEREST

The Real Party of Interest is Shutterfly Inc., a Delaware corporation.

#### RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences for the above-referenced patent application.

#### STATUS OF CLAIMS

Claims 1-155 are pending and are the subject of this Appeal. All claims have been rejected. Claims 1-155 are the subject of this appeal. No other claims are pending.

#### STATUS OF AMENDMENTS

An Initial Office Action mailed 9/11/03 objected to informality in the Specification. Further, claims 1-8, 12-13, 30-42, 44-48, 57-58, 80-87, 91-92, 107-115 and 132 were rejected under Section 103(a) as unpatentable over Fredlund (5,666,215) and Johnson (6,052,670). Claims 9-11 and 88-90 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, and Shiota (6,324,521). Claims 14 and 93 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Tackbary (5,555,496). Claims 15-25, 27-28, 94-102 and 104-105 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Cok (6,157,436). Claims 26 and 103 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Shiota. Claim 29 was rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Clark (4,854,094). Claim 43 was rejected under Section 103(a)

as unpatentable over Fredlund, Johnson and Stancato (5,056,823). Claims 49-51 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Tackbary. Claims 52-53 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Brewen (4,872,706). Claims 54-56 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Stancato. Claims 59-61, 71-75 and 77-78 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Cok. Claim 62 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Klees (5,652,936). Claims 63-65 and 69 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Cok. Claims 66-68 and 76 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Shiota. Claim 70 was rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Tackbary. Claim 79 and 106 was rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Clark. Claims 116-119 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Shiota. Claim 120 was rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Shiota and Clark. Claims 121-126 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Shiota and Cok. Claims 127, 130 and 131 were rejected under Section 103(a) as unpatentable over Fredlund, Klees and Shiota. Claims 128-129 were rejected under Section 103(a) as unpatentable over Fredlund, Klees, Shiota and Ohtsuka (EPO 98118497.1). Claims 133-146 were rejected under Section 103(a) as unpatentable over Fredlund and Cok. Claims 147-153 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson and Cok. Finally, claims 154-155 were rejected under Section 103(a) as unpatentable over Fredlund, Johnson, Cok and Shiota.

Appellants filed a Response on October 1, 2003 traversing the Section 103 rejections. In a Final Office Action mailed on October 28, 2003, the same rejections were reiterated. Appellants amended some of the claims and traversed the rejections on January 27, 2004. A Notice of Appeal from the Examiner to the Board of Patent Appeals and Interferences, under 37 C.F.R. § 1.191, was also filed on January 27, 2004. An Advisory Action was mailed on February 12, 2004 indicating that the proposed amendments were not entered as they are not deemed to place the application in better form for appeal. An Appellant's Brief on Appeal was mailed 5/27/04.

In response, an Office Action mailed 8/26/04 reopened prosecution. Claims 1-8, 10, 12-13, 15-24, 30-52, 57-61, 63-65, 67, 69, 71-74, 80-87, 89, 91-92, 94-101, 107-115, 132-149, 152, and 154 were rejected as anticipated by Fredlund et al. under 35 U.S.C. 102(b). Claims 9, 11, 14, 66, 68, 70, 88, 90, & 93 were rejected as unpatentable over Fredlund et al in view of Tackbarry et al. under 35 U.S.C. 103(a). Claims 25-29, 75-79, 102-106, 116-126, 150-151, 153, & 155 were rejected as unpatentable over Fredlund et al in view of Cok under 35 U.S.C. 103(a); Claim 53 were rejected as unpatentable over Fredlund et al in view of Brewen under 35 U.S.C. 103(a); Claims 54-56 were rejected under 35 U.S.C. 103(a) are patentable over Fredlund et al in view of Stancato under 35 U.S.C. 103(a); Claim 62 was rejected under 35 U.S.C. 103(a) as unpatentable over Fredlund et al in view of Klees et al. under 35 U.S.C. 103(a); and Claims 127-131 were rejected as unpatentable over Fredlund et al in view of Klees et al as applied to claim 62, and further in view of Cok.

#### SUMMARY OF THE INVENTION

Briefly, in one aspect, Appellant's invention relates to a computer-implemented method of distributing image prints to a plurality of recipients (including, e.g., an individual, a business entity, and/or an address) may include receiving an order specifying a plurality of recipients (e.g., where at least one of the specified recipients is different from a user from whom the order was received) and, for each specified recipient, a set of one or more images associated with that recipient. The method also may include, for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set and distributing the printed image copies to their respective associated recipients.

In another aspect, a computer-implemented method of distributing physical manifestations of digital content to a plurality of recipients may include receiving an order specifying a plurality of recipients and, for each specified recipient, a set of digital content (e.g., one or more digital images) associated with that recipient. The method may also include for each of the plurality of recipients specified in the received order, generating a physical manifestation of the digital content in the recipient's digital content set, and distributing the

physical manifestations to their respective associated recipients. The physical manifestation of the digital content may include photographic prints of the one or more digital images, framed photographic prints, photo-album pages bearing one or more digital images, compositions of digital images and other graphical and/or textual content, and/or artifacts bearing a digital image such as a novelty item, a shirt, a coffee mug, a key-chain, a mouse pad, a magnet, or a deck of playing cards.

In another aspect, a computer-implemented method of distributing photographic prints to a plurality of recipients may include receiving an order specifying (i) a plurality of recipients, (ii) for each specified recipient, a set of one or more digital images associated with that recipient, and (iii) for each digital image, a set of one or more print parameters (e.g., print size, number of copies, print finish, and/or a textual message). The method also may include dividing the received order into a plurality of sub-orders so that each sub-order corresponds to a different specified recipient and includes an instance of each digital image associated with the recipient corresponding to the sub-order. The method further may include printing the instantiated digital images in each of the sub-orders according to the print parameters associated with each image, and distributing the prints to their respective associated recipients. The order may be received by receiving interactive input from a user of a computer system (e.g., the user's personal computer system or a public entry terminal).

In another aspect, a method of distributing photographic prints to users may include receiving from a user a computer-readable medium bearing one or more digital images, processing the one or more digital images to generate one or more photographic prints, storing computer software on the computer-readable medium received from the user, and sending the one or more photographic prints and the computer-readable medium storing computer software to the user.

In another aspect, a print distribution system may include a front-end computer sub-system for receiving an order specifying a plurality of recipients (including, e.g., an individual, a business entity, and/or an address) and, for each specified recipient, a set of one or more images associated with that recipient. The system also may include a printing sub-system for printing at least one copy of each image in each recipient's image set, and a distribution sub-system for

distributing the printed image copies to their respective associated recipients. At least one of the specified recipients may be different from a user from whom the order was received.

In another aspect, a method of facilitating print re-orders includes receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient. The method also may include, for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set and printing a re-order number on a back of each image copy. The re-order number may uniquely identify the image, the recipient of that image, and/or the originator of that image. The method also may include distributing the printed image copies to their respective associated recipients, receiving input (e.g., using an automatic voice or touchtone response system) from a recipient specifying a print re-order number and/or one or more print parameters associated with the print re-order, generating a print of the image associated with the print re-order number, and sending the print to the recipient associated with the print re-order number. Furthermore, the order may include a single transaction sequence such as a single charge to a financial instrument (e.g., a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon) that may be terminated by a click of an "order" button.

In another aspect, a computer-implemented method of distributing image prints to a plurality of recipients may include receiving, at a facility corresponding to a first entity (e.g., a photo-finishing enterprise), an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient. The method also may include communicating the received order to a facility corresponding to a second entity (e.g., a goods / service provider enterprise such as a supermarket, a drugstore, a post office, or an online grocer). The method further may include, at the second entity's facility, for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set, and distributing the printed image copies to their respective associated recipients. Distributing the printed image copies may include delivering a recipient's printed image copies along with an unrelated order of goods / services associated with that recipient.

In another aspect, a computer-implemented method of distributing image prints to a plurality of recipients may include receiving an order from a user at a public entry terminal (e.g.,

a digital drop box, a point-of-sale station, or a kiosk), the order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient. The method also may include transmitting the received order from the public entry terminal to a photo-finishing facility. The method further may include printing, for each of the plurality of recipients specified in the received order, at the photo-finishing facility at least one copy of each image in the recipient's image set and distributing the printed image copies to their respective associated recipients.

In another aspect, a computer-implemented method of ordering image prints for a plurality of recipients may include receiving at a host system an order from a client system, where the order includes a single transaction sequence and specifies a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient. The method further may include, at the host system, dividing the received order into a plurality of sub-orders, where each sub-order corresponds to a different recipient. The method also may include printing a set of one or more images in each sub-order and/or printing, for each sub-order, a run of prints associated with a specified recipient. Moreover, the method may include printing a destination identifier that identifies the specified recipient for a corresponding run of prints. The destination identifier may delimit a corresponding sub-order and/or may include one or more of the following items: a shipping address, a recipient's name, a thumbnail image index, a bar code, a textual message and/or print re-ordering information.

In another aspect, a computer-implement method of processing an order for a physical manifestation of digital content may include receiving an order specifying a plurality of recipients and, for each specified recipient, a set of digital content associated with that recipient. The method also may include dividing the received order into a plurality of sub-orders (each sub-order corresponding to a different recipient) by instantiating a digital copy of the digital content for each recipient designated to receive a physical manifestation of that digital content. The method further may include generating a physical manifestation of the digital content in the recipient's digital content set. The digital content may include a digital image and the physical manifestation may include a photographic print of the digital image.

One or more of the following advantages may be provided. The systems and techniques provide intuitive and convenient mechanisms that allow a user to order prints of images and have the prints distributed to multiple recipients at different locations with a minimum of time, trouble and expense on the part of the ordering user. For example, in a single ordering sequence, a user can specify a set of one or more prints and have them distributed to multiple different recipients. As a result, the user need not reenter redundant information – for example, identifying the images to be printed, supplying payment information, and the like – as otherwise would be required if the print order was limited to a single shipping destination. Moreover, by allowing a user to specify multiple recipients within a single print order, the user is not subjected to a minimum dollar amount for each of several different orders. Rather, because multiple recipients are allowed, the user is better able to satisfy the minimum dollar amount without being forced to order more prints than otherwise would be desired.

In addition, because an order can designate multiple recipients, the user need not incur multiple charges on a credit card or other financial instrument when ordering prints for multiple recipients. Furthermore, by allowing the user to specify different print parameters (e.g., size, number of copies, finish) for each of the individual recipients, flexibility and convenience in the print ordering process are enhanced.

Moreover, users can distribute copies of prints to multiple recipients without having to incur the effort and expense involved in receiving print copies from a photofinisher, sorting the prints into sets according to destinations, putting the prints in protective envelopes, and then re-mailing the sets of prints to their respective recipients. As a result, sets of prints can be distributed to multiple destinations more quickly and with less expense and effort.

In addition, by employing a non-linear workflow model certain benefits and efficiencies are realized. More particularly, by taking a single multiple-recipient order, breaking it down into sub-orders corresponding to a single recipient, selectively instantiating and re-organizing multiple instances of designated images to build each sub-order, and then printing each sub-order as a separate run of prints for the associated recipient, a single print order (transaction sequence) can be used to order prints to be generated and distributed to multiple recipients. Moreover, such



a non-linear workflow tends to increase the efficiency and/or speed of the print generation and distribution tasks dramatically.

#### ISSUES PRESENTED FOR REVIEW

- I. WHETHER CLAIMS 1-8, 10, 12-13, 15-24, 30-52, 57-61, 63-65, 67, 69, 71-74, 80-87, 89, 91-92, 94-101, 107-115, 132-149, 152, & 154 ARE ANTICIPATED BY FREDLUND ET AL. UNDER 35 U.S.C. 102(B)
- II. WHETHER CLAIMS 9, 11, 14, 66, 68, 70, 88, 90, & 93 ARE PATENTABLE OVER FREDLUND ET AL IN VIEW OF TACKBARRY ET AL. UNDER 35 U.S.C. 103(A)
- III. WHETHER CLAIMS 25-29, 75-79, 102-106, 116-126, 150-151, 153, & 155 ARE PATENTABLE OVER FREDLUND ET AL IN VIEW OF COK UNDER 35 U.S.C. 103(A)
- IV. WHETHER CLAIM 53 ARE PATENTABLE OVER FREDLUND ET AL IN VIEW OF BREWEN UNDER 35 U.S.C. 103(A)
- V. WHETHER CLAIMS 54-56 WERE REJECTED UNDER 35 U.S.C. 103(A) ARE PATENTABLE OVER FREDLUND ET AL IN VIEW OF STANCATO UNDER 35 U.S.C. 103(A)
- VI. WHETHER CLAIM 62 IS REJECTED UNDER 35 U.S.C. 103(A) ARE PATENTABLE OVER FREDLUND ET AL IN VIEW OF KLEES ET AL. UNDER 35 U.S.C. 103(A)
- VII. WHETHER CLAIMS 127-131 ARE PATENTABLE OVER FREDLUND ET AL IN VIEW OF KLEES ET AL AS APPLIED TO CLAIM 62, AND FURTHER IN VIEW OF COK UNDER 35 U.S.C. 103(A)

#### GROUPING OF CLAIMS

For each ground of rejection that appellant contest herein, which applies to more than one claim, such additional claims, to the extent separately identified and argued below, do not stand or fall together.

## ARGUMENT

I. CLAIMS 1-8, 10, 12-13, 15-24, 30-52, 57-61, 63-65, 67, 69, 71-74, 80-87, 89, 91-92, 94-101, 107-115, 132-149, 152, & 154 ARE NOT ANTICIPATED BY FREDLUND ET AL. UNDER 35 U.S.C. 102(B)

Claims 1-8, 10, 12-13, 15-24, 30-52, 57-61, 63-65, 67, 69, 71-74, 80-87, 89, 91-92, 94-101, 107-115, 132-149, 152, & 154 were rejected under 35 U.S.C. 102(b) as being anticipated by Fredlund et al. (5,666,215). The Office Action noted that:

Re claims 1-2, 7-8, 12-13, 15-17, 30-33, 39-41, 43, 59-61, 64-65, 69, 80-81, 86-87, 91-92, 94-96, 107-110, 132-135, 143, 147-149, & 152, Fredlund et al discloses (Abstract; column 2, lines 28-42; column 5, lines 32-51; column 6, lines 30-42; column 7, lines 18-30) a computer-implemented method and print system in which a user may select a series of images to be photographically printed and respectively sent to a recipient address by a single entity (a photo processing station: see column 6, lines 17-42).

Further re claims 1-2, 7-8, 12-13, 15-17, 30-33, 39-41, 43, 59-61, 64-65, 69, 80-81, 86-87, 91-92, 94-96, 107-110, 132-135, 143, 147-149, & 152, while Fredlund et al describes the set of images selected to be sent to one recipient as an "order", a sequence in which one set of images is designated for printing and sending to one recipient and then (column 6, lines 30-33) another set of images is immediately selected for printing and sending to a different recipient (and so on until all desired images and recipients are selected) is readable upon Applicant's use of the term "order specifying a plurality of recipients" (which would then consist of several "sub-orders", each being sent to a given recipient), inasmuch as the present claim language does not preclude the reading of such a multi-recipient session upon the term "order" as used in the present claims.

Further re claims 3-6, 22, 44, 48, 51, 57-58, 63, 82-85, 140, & 144-146, Fredlund et al discloses (column 7, lines 60-64), the computer-aided customization of image print parameters (including a text message) for individual images to be sent to respective recipients.

Further re claim 10, 67, 89, & 154, Fredlund et al discloses (Figure 3; column 5, lines 14-16) the provision of a front-end graphical user interface that is used to present information and collect user inputs to be remotely transmitted.

Further re claims 18-21, 71-74, 97-99, & 136-139, Fredlund et al discloses (column 8, lines 12-15) the printing of an address label (inherently including the recipient's name and address, as the absence of this information would make the "address label" fail in the purpose of indicating a destination address).

Further re claims 23-24, 45, 100-101, & 141-142, Fredlund et al discloses (column 7, lines 26-30) the production of an instant digital copy of an ordered image in the form of a Photo CD (a medium containing one or more digital image files).

Further re claims 34 & 111, the specified recipient differs from the customer in any case in which the customer enters any address other than his own as a recipient address area 70 (column 6, lines 23-25).

Further re claims 35-38 & 112-115, the sequence in which one set of images is designated for sending to one recipient and then (column 6, lines 30-33) another set of images is immediately selected for sending to a different recipient (and so on until all desired images and recipients are selected) comprises at least one charge (which is readable upon a recitation of "a single charge" unaccompanied by limitations precluding a plurality of charges) to a financial instrument (column 6, lines 30-41) such as a credit card (column 6, lines 45-46). The sequence is terminated (in the case where the user wishes to go ahead with the planned order) by pressing a "send" button to place the order (column 6, lines 53-54).

Further re claim 42, Fredlund et al discloses (column 7, lines 60-64) the printing of an image to be sent to a designated recipient in the form of a framed print.

Further re claims 46-47, Fredlund et al discloses (column 7, lines 49-51) the printing of an image upon a novelty item such as a customized coffee mug or T-shirt.

Further re claims 49-50, Fredlund et al discloses (Figure 3) the printing of an image upon a card (3x5, 4x6, etc).

Further re claim 52, the text message of Fredlund et al (column 7, lines 60-64) is readable upon the recited "advertisement" in the case where the user enters an advertising statement as the selected text.

Fredlund shows a system where a photographic image can be viewed at a customer's location on her personal computer and images selected for initial printing, reprinting and ordering related image services. In this case, a First Office Action dated 9/11/03 noted that "[t]he difference between Fredlund and the claimed invention is that Fredlund discloses sending multiple orders to a plurality of recipients instead of a single order specifying a plurality of recipients.

The rejection is unsupportable in light of the requirement of the Section 102 rejection, which requires that each and every element of each claim be present in Fredlund. The instant Office Action relied on Col. 6, lines 30-33 of Fredlund as showing this element. However, as noted in the First Office Action, Col. 6, lines 30-33 does not show the claimed order specifying a

plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient.

Using hindsight to reconstruct the invention, the current Office Action takes an inconsistent position with that in the First Office Action as follows:

Fredlund describes the set of images selected to be sent to one recipient as an "order", a sequence in which one set of images is designated for printing and sending to one recipient and then (column 6, lines 30-33) another set of images is immediately selected for printing and sending to a different recipient (and so on until all desired images and recipients are selected) is readable upon Applicant's use of the term "order specifying a plurality of recipients" (which would then consist of several "sub-orders", each being sent to a given recipient), inasmuch as the present claim language does not preclude the reading of such a multi-recipient session upon the term "order" as used in the present claims.

The instant Office Action asserts but fails to show any teaching in Fredlund showing a plurality of recipients in an order. The language "another set of images is immediately selected for printing and sending to a different recipient (and so on until all desired images and recipients are selected)" constitutes hindsight from the present disclosure that was not present in Fredlund. In fact, the paragraph cited by the examiner expressly teaches that "The order information interface includes an area 70 for entering the shipping address for the order, an area 72 for entering a message for the recipient of the order, an area 77 for any special instructions to the photo processing lab." Thus, Fredlund does not show a plurality of recipients in an order, but a recipient in an order.

Moreover, Fredlund does not show the claimed "for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set" since Fredlund cannot handle a plurality of recipients per order.

In sum, Fredlund fails to show a number of claimed elements. The claimed systems and techniques provide intuitive and convenient mechanisms that allow a user to order prints of images and have the prints distributed to multiple recipients at different locations with a minimum of time, trouble and expense on the part of the ordering user. For example, in a single ordering sequence, a user can specify a set of one or more prints and have them distributed to multiple different recipients. As a result, the user need not reenter redundant information – for

example, identifying the images to be printed, supplying payment information, and the like – as otherwise would be required if the print order was limited to a single shipping destination. Moreover, by allowing a user to specify multiple recipients within a single print order, the user is not subjected to a minimum dollar amount for each of several different orders. Rather, because multiple recipients are allowed, the user is better able to satisfy the minimum dollar amount without being forced to order more prints than otherwise would be desired. In addition, because an order can designate multiple recipients, the user need not incur multiple charges on a credit card or other financial instrument when ordering prints for multiple recipients. Furthermore, by allowing the user to specify different print parameters (e.g., size, number of copies, finish) for each of the individual recipients, flexibility and convenience in the print ordering process are enhanced.

According to MPEP 2131, to anticipate a claim, the reference must teach every element of the claim. In particular, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Here, the Fredlund reference fails to teach each and every element set forth in the independent claims of the instant application.

Since Fredlund expressly teaches one recipient and not a plurality of recipients, the Section 102 rejection fails since it cannot show the presence of the claimed "receiving an order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient" in Fredlund. In view of the foregoing, the independent claims including claims 1, 39, 59, 80, 116, 127, 132 and 147 are not anticipated by Fredlund. Withdrawal of the Section 102 Rejection on the independent claims is requested.

The dependent claims are allowable because they depend from an allowable claim. In addition, with respect to dependent claims, a number of claimed specifics are missing. For claims 2-8, 10, 12-13, 15-24, 30-52, 57-61, 63-65, 67, 69, 71-74, 80-87, 89, 91-92, 94-101, 107-115, 132-149, 152, and 154, Fredlund does not show an order with a plurality of recipients where images in a first recipient's image set differ from images in a second recipient's image set. Fredlund does not show an order with a plurality of recipients where print parameters of a first

recipient's image set differ from printing parameters of a second recipient's image set. Fredlund does not show an order with a plurality of recipients where print parameters include one or more of print size, number of copies, print finish, and/or a textual message. Fredlund does not show an order with a plurality of recipients where print parameters differ among images within an image set. Fredlund does not show an order with a plurality of recipients where print parameters include one or more of print size, number of copies, print finish, and/or a textual message. Fredlund does not show an order with a plurality of recipients where each image set comprises an arbitrary grouping of images designated by a user. Fredlund does not show an order with a plurality of recipients where receiving, printing and distributing are performed by a single entity. Fredlund does not show an order with a plurality of recipients where receiving an order is performed by an enterprise providing a web front-end. Fredlund does not show an order with a plurality of recipients where printing and distributing are integrated processes, or where printing and distributing are performed by a single entity. Fredlund does not show an order with a plurality of recipients where prior to printing, the received order is divided into a plurality of sub-orders, each sub-order corresponding to a different recipient or the printing a set of one or more images in each sub-order or for each sub-order, printing a run of prints associated with a specified recipient. Fredlund does not show an order with a plurality of recipients including printing a destination identifier that identifies the specified recipient for a corresponding run of prints. Fredlund does not show an order with a plurality of recipients where the destination identifier delimits a corresponding sub-order or where printing the destination identifier comprises printing one or more of the following items: a shipping address, a recipient's name, a thumbnail image index, a bar code, a textual message and/or print re-ordering information. Fredlund does not show an order with a plurality of recipients where dividing the received order into the plurality of sub-orders comprises, for each image in the received order, instantiating a copy of the image for each recipient designated to receive a print of that image. Fredlund does not show an order with a plurality of recipients where an instantiated copy comprises a digital image file. Fredlund does not show an order with a plurality of recipients where at least one of the specified recipients is different from a user from whom the order was received. Fredlund does not show an order with a plurality of recipients where the order comprises a single

transaction sequence. Fredlund does not show an order with a plurality of recipients where the single transaction sequence comprises a single charge to a financial instrument. Fredlund does not show an order with a plurality of recipients where the single transaction sequence is terminated by a click of an "order" button.

In sum, since a number of claimed elements are missing in Fredlund, the claims cannot be anticipated by Fredlund. Withdrawal of the rejection is requested.

II. CLAIMS 9, 11, 14, 66, 68, 70, 88, 90, & 93 ARE PATENTABLE OVER FREDLUND ET AL IN VIEW OF TACKBARRY ET AL. UNDER 35 U.S.C. 103(A)

Claims 9, 11, 14, 66, 68, 70, 88, 90, & 93 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Tackbarry et al as follows:

Re claims 9, 11, 14, 66, 68, 70, 88, 90, & 93, Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 3 supra (i.e. by a single entity).

Fredlund et al does not disclose expressly the division of these steps among separate entities.

Tackbarry et al discloses (column 12, line 55 - column 13, line 3) an order receiving, printing, and distribution process for picture prints in which the distribution process is carried out by an entity different from the entity that receives and prints orders.

Fredlund et al and Tackbarry et al are combinable because they are from the field of online order receiving, printing, and distribution process for picture prints. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Tackbarry et al system of print distribution.

The suggestion/motivation for doing so would have been allow the use of established distribution channels (such as those taught by Tackbarry et al at column 9, lines 9-11).

Therefore, it would have been obvious to combine Fredlund et al with Tackbarry et al to obtain the invention as specified in claims 9, 11, 14, 66, 68, 70, 88, 90, & 93.

A quick review of the requirement for a *prima facie* case of obviousness is helpful. Per

MPEP 706.02(j): Contents of a 35 U.S.C. 103 Rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either

in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Appellant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP Section 2143 - Section 2143.03 for decisions pertinent to each of these criteria.

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP Section 2144 - Section 2144.09 for examples of reasoning supporting obviousness rejections.

Appellants respectfully traverse the rejection of claims 9, 11, 14, 66, 68, 70, 88, 90, and 93 as unpatentable since neither the patents cited in the Final Office Action, nor any other evidence of record establish a *prima facie* case of obviousness of claims 9, 11, 14, 66, 68, 70, 88, 90, and 93.

First, the claims are allowable because they depend from allowable independent claims. Further, there is no showing that the receiving, printing and distributing of orders with multiple recipients are dispersed among two or more different entities. Moreover, there is no showing that the printing or distributing, or both, of orders with multiple recipients are performed by a fulfillment enterprise different than the enterprise providing the web front-end. Additionally, there is no showing that the printing and distributing are performed by different entities for orders with multiple recipients.

The Office Action fails to show any evidence in Tackbarry or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund



so as to produce the claimed invention. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson and Tackbary reference, or knowledge of those skilled in the art, for *prima facie* obviousness of these claims has not been established.

Here, besides a conclusory statement using hindsight provided by the teaching of the instant case that the combination “allow the use of established distribution channels (such as those taught by Tackbary et al at column 9, lines 9-11)”, the Office Action has not pointed to any evidence Tackbary or Fredlund of the presence of the specifics claims 9, 11, 14, 66, 68, 70, 88, 90, and 93 or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings). Since the Office Action failed to show the claimed specifics, this is an independent reason for traversing the rejection. Withdrawal of the rejection is requested.

Appellant notes that the present rejection does not establish *prima facie* obviousness under 35 U.S.C. § 103 and M.P.E.P. §§ 2142-2143. The Examiner bears the initial burden to establish and support *prima facie* obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976). To establish *prima facie* obviousness, three basic criteria must be met. M.P.E.P. § 2142. First, the Examiner must show some suggestion or motivation, either in the Johnson et al. reference or in the knowledge generally available to one of ordinary skill in the art, to modify the reference Fredlund so as to produce the claimed invention. M.P.E.P. § 2143.01; *In re Fine*, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Secondly, the Examiner must establish that there is a reasonable expectation of success for the modification. M.P.E.P. § 2142. Thirdly, the Examiner must establish that the prior art references teach or suggest all the claim limitations. M.P.E.P. § 2143.03; *In re Royka*, 180 U.S.P.Q. 580 (CCPA 1974). The teachings, suggestions, and reasonable expectations of success must be found in the prior art, rather than in Appellant's disclosure. *In re Vaeck*, 20 U.S.P.Q.2d 1438 (CAFC 1991). Appellant respectfully submits that

a *prima facie* case of obviousness has not been met because the Examiner's rejection fails on at least two of the above requirements. Additionally, the Examiner has not established reasonable expectation of success for the modification. Moreover, the prior art references do not teach the claim limitation of a single order specifying a plurality of recipients. Moreover, the teachings, suggestions, and reasonable expectations of success were not found in the prior art, but in Appellant's disclosure.

Moreover, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

The evidence also indicates that there was no reasonable expectation of success when combining the Johnson catalog for standardized products with the Fredlund unique image system. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (Claims directed to a method for the commercial scale production of polyesters in the presence of a solvent at superatmospheric pressure were rejected as obvious over a reference which taught the claimed method at atmospheric pressure in view of a reference which taught the claimed process except for the presence of a solvent. The court reversed, finding there was no reasonable expectation that a process combining the prior art steps could be successfully scaled up in view of unchallenged evidence showing that the prior art processes individually could not be

commercially scaled up successfully.). *See also Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207-08, 18 USPQ2d 1016, 1022-23 (Fed. Cir.), cert. denied, 502 U.S. 856 (1991) (In the context of a biotechnology case, testimony supported the conclusion that the references did not show that there was a reasonable expectation of success.); *In re O'Farrell*, 853 F.2d 894, 903, 7 USPQ2d 1673, 1681 (Fed. Cir. 1988) (The court held the claimed method would have been obvious over the prior art relied upon because one reference contained a detailed enabling methodology, a suggestion to modify the prior art to produce the claimed invention, and evidence suggesting the modification would be successful.).

Appellants have provided evidence pointing away from obviousness and in accordance with MPEP Section 2143.01:

If the examiner determines there is factual support for rejecting the claimed invention under 35 U.S.C. 103, the examiner must then consider any evidence supporting the patentability of the claimed invention, such as any evidence in the specification or any other evidence submitted by the Appellant. The ultimate determination of patentability is based on the entire record, by a preponderance of evidence, with due consideration to the persuasiveness of any arguments and any secondary evidence. In *re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The legal standard of "a preponderance of evidence" requires the evidence to be more convincing than the evidence which is offered in opposition to it. With regard to rejections under 35 U.S.C. 103, the examiner must provide evidence which as a whole shows that the legal determination sought to be proved (i.e., the reference teachings establish a *prima facie* case of obviousness) is more probable than not.

When an Appellant submits evidence, whether in the specification as originally filed or in reply to a rejection, the examiner must reconsider the patentability of the claimed invention. The decision on patentability must be made based upon consideration of all the evidence, including the evidence submitted by the examiner and the evidence submitted by the Appellant. A decision to make or maintain a rejection in the face of all the evidence must show that it was based on the totality of the evidence. Facts established by rebuttal evidence must be evaluated along with the facts on which the conclusion of obviousness was reached, not against the conclusion itself. In *re Eli Lilly & Co.*, 902 F.2d 943, 14 USPQ2d 1741 (Fed. Cir. 1990).

The combination suggested in the office action was done using selective hindsight. There is simply no suggestion or motivation in Johnson to modify Fredlund to arrive at a computer-implemented method of distributing image prints to a plurality of recipients by receiving an order

specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; for each of the plurality of recipients specified in the received order, printing at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipient.

Appellant points out that the Examiner bears the initial burden of factually establishing and supporting any *prima facie* conclusion of obviousness. *In re Rinehart*, 189 U.S.P.Q. 143 (CCPA 1976); M.P.E.P. § 2142. If the Examiner does not produce a *prima facie* case, the Appellant is under no obligation to submit evidence of nonobviousness. *Id.* In the instant case, the Examiner has not pointed to any evidence in Johnson or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed invention of claim 1 of a single order with multiple recipients. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) ([I]n a determination of patentability .... the Board cannot simply reach conclusions based on its understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson reference, or knowledge of those skilled in the art, for a single order specifying a plurality of recipients, *prima facie* obviousness of claim 1 (and dependent claims) has not been established. In sum, it is respectfully requested that the § 103(a) rejection of all claims be withdrawn.

III. CLAIMS 25-29, 75-79, 102-106, 116-126, 150-151, 153, & 155 ARE  
PATENTABLE OVER FREDLUND ET AL IN VIEW OF COK UNDER 35 U.S.C.  
103(A)

Claims 25-29, 75-79, 102-106, 116-126, 150-151, 153, & 155 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Cok as follows:

Re claims 25-27, 75-77, 102-104, 116-118, 121-126, 150-151, & 153, Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 3 *supra*.

Re claims 28, 78, 105, 119, & 151, Fredlund et al further discloses (column 3, lines 19-42) the provision of photo prints via a photo store, supermarket, or drugstore.

Re claims 29, 79, 106, 120, & 155, in the case in which a user purchases prints from such a provider and also orders other goods and services provided therefrom, the two will be distributed via the same channel.

Fredlund et al does not disclose expressly the receipt and dividing of an order by an entity different from the entity that performs the printing of the order.

Cok discloses (column 2, line 60 - column 3, line 7) the receiving and dividing of an order by one entity (a processor) and the printing of the order by a separate entity (a set of output systems) that provide the service of printing.

Fredlund et al and Cok are combinable because they are both from the field of online order receiving, printing, and distribution process for picture prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Cok set of output systems.

The suggestion/motivation for doing so would have been distribute the printout load in order to provide outputs of various desired formats (as described by Cok at column 3, lines 7-9).

Therefore, it would have been obvious to combine Fredlund et al with Cok to obtain the invention as specified in claims 25-29 & 75-79.

The method of claim 15 wherein dividing the received order into the plurality of sub-orders is performed by a first entity and printing the sub-orders is performed by a second entity.

26. The method of claim 25 wherein the first entity comprises a photo-finishing enterprise.

27. The method of claim 25 wherein the second entity comprises a goods / service provider enterprise.

28. The method of claim 25 wherein the second entity comprises a supermarket, a drugstore, a post office, or an online grocer.

29. The method of claim 25 wherein distributing the printed image copies comprises delivering a recipient's printed image copies along with an unrelated order of goods / services associated with that recipient.

#### IV. CLAIM 53 IS PATENTABLE OVER FREDLUND ET AL IN VIEW OF BREWEN UNDER 35 U.S.C. 103(A)

Claim 53 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Brewen. The Office Action noted:

Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 3 supra.

Fredlund et al does not disclose expressly a picture print in the form of a coupon. Brewen discloses (Figure 3) the production of a picture print in the form of a coupon. Fredlund et al and Brewen are combinable because they are both from the field of digital image selection and printing.

At the time of the invention, would have been obvious to a person of ordinary skill in the art to use the Fredlund et al system of order receiving, printing, and distributing process of picture prints to print a picture whose content is that of the coupon disclosed by Brewen.

The suggestion/motivation for doing so would have been to use a known system of order receiving, printing, and distributing process of picture prints to produce a specific type of desired image printout.

Therefore, it would have been obvious to combine Fredlund et al with Brewen to obtain the invention as specified in claim 53.

Claim 53 depends from the allowable independent claim, and therefore it is allowable. Moreover, the Office Action fails to show any evidence in Brewen or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to produce the claimed invention. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaech*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson and Tackbary reference, or knowledge of those skilled in the art, for *prima facie* obviousness of the claims has not been established. Moreover, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

V. CLAIMS 54-56 WERE REJECTED UNDER 35 U.S.C. 103(A) ARE PATENTABLE OVER FREDLUND ET AL IN VIEW OF STANCATO UNDER 35 U.S.C. 103(A)

Claims 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Stancato as follows:

Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 3 *supra*.

Fredlund et al does not disclose expressly the binding of picture prints in the form of a bound volume such as an album or travel book.

Stancato discloses (column 1, lines 6-16) the production of a bound volume of picture prints (which inherently constitutes a "photo-album", and constitutes a "travel book" in the case where the user selects images for the purpose of documenting and illustrating travel).

Fredlund et al and Stancato are combinable because they are from the field of digital image selection and printing.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Fredlund et al system of order receiving, printing, and distributing process of picture prints to print pictures which are bound in the volume described by Stancato.

The suggestion/motivation for doing so would have been to use a known system of order receiving, printing, and distributing process of picture prints to produce a set of images that are bound for protection and convenient access.

Therefore, it would have been obvious to combine Fredlund et al with Stancato to obtain the invention as specified in claims 54-56.

Stancato relates to a design associated with the fabrication and construction of a prebound album wherein the individual pages of the album are selectively interchangeable, each particular page evidencing a new and unique method of fabrication and construction capable or having mounted thereon a photograph or other item for display purposes so as to achieve an overall aesthetically appearing album design. However, there is nothing in Stancato that relates to a physical manifestation of digital content as photo-album pages bearing one or more digital images.

First, claims 54-56 depend from allowable claims, and therefore it is allowable. Moreover, the Office Action fails to show any evidence in Stancato or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund to produce the claimed physical manifestation of the set of digital content comprises a bound volume bearing the graphical and/or textual content and wherein the bound volume is a photo-album or a travel book. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaech*, absent any evidence of a cited suggestion or reasonable motivation in the references, or knowledge of those skilled in the art, *prima facie* obviousness of claim 54-56 has not been established. Moreover, the claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

VI. CLAIM 62 IS REJECTED UNDER 35 U.S.C. 103(A) ARE PATENTABLE OVER FREDLUND ET AL IN VIEW OF KLEES ET AL. UNDER 35 U.S.C. 103(A)

Claim 62 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Klees et al. The Office Action noted:

Fredlund et al discloses the order receiving, printing, and distributing process of picture prints as described in paragraph 3 supra.

Fredlund et al does not disclose expressly that the computer system used for order input is a public entry terminal. Klees et al discloses (column 2, line 29 - column 3, line 4; particularly column 2, lines 53-57) the use of a publicly accessible terminal to enter a picture print order.

Fredlund et al and Klees et al are combinable because they are both from the field of order receiving, printing, and distribution process for picture prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use a publicly accessible terminal to accept orders into the Fredlund et al system of order receiving, printing, and distributing process of picture prints.

The suggestion/motivation for doing so would have been so that customers who do not possess individual personal computers may be served.

Therefore, it would have been obvious to combine Fredlund et al with Klees et al to obtain the invention as specified in claim 62.

Klees relates to workstation for interaction of a customer at the apparatus thereby providing instructions to the customer for ordering processing of an undeveloped photosensitive material. The workstation includes a first display device for providing instructions and information to the customer for use in said apparatus, for entering data responsive to said instructions; an acceptance device for receiving image data; a printing mechanism for issuing a customer claim check having a unique identification indica; and a second display visually separate from the workstation for displaying the status of various customer orders.

The Office Action fails to show any evidence in Klees or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching Fredlund so as to result in the claimed public entry terminal that operates in accordance with allowable claim 59. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001). Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the reference, or knowledge of those skilled in the



art, for *prima facie* obviousness of the claims has not been established. Withdrawal of the rejection is respectfully requested.

VII. CLAIMS 127-131 ARE PATENTABLE OVER FREDLUND ET AL IN VIEW OF KLEES ET AL AS APPLIED TO CLAIM 62, AND FURTHER IN VIEW OF COK UNDER 35 U.S.C. 103(A)

Claims 127-131 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fredlund et al in view of Klees et al as applied to claim 62 above, and further in view of Cok as follows:

Re claims 127-131, Fredlund et al in view of Klees et al teaches the order receiving, printing, and distributing process of picture prints, with the order receiving implemented through a public terminal kiosk, as described in paragraph 9 *supra*. Further re claims 128-129, Fredlund et al discloses (column 7, lines 26-30) the production of an instant digital copy of an ordered image in the form of a Photo CD (a computer-readable medium containing one or more digital image files). Fredlund et al does not disclose expressly the receipt and dividing of an order by an entity different from the entity that performs the photo printing of the order. Cok discloses (column 2, line 60 - column 3, line 7) the receiving and dividing of an order by one entity (a processor) and the printing of the order by a separate entity (a set of output systems) that provide the service of printing.

Fredlund et al and Cok are combinable because they are both from the field of online order receiving, printing, and distribution process for picture prints.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the Cok set of output systems.

The suggestion/motivation for doing so would have been distribute the printout load in order to provide outputs of various desired formats (as described by Cok at column 3, lines 7-9). Therefore, it would have been obvious to combine Fredlund et al with Cok to obtain the invention as specified in claims 25-29 & 75-79.

These claims are allowable as they depend from allowable independent claims.

Additionally, the Office Action failed to show any evidence in Cok, Klees or how knowledge of those skilled in the art, provide a suggestion or motivation to modify the reference teaching so as to produce the claimed receiving an order from a user at a public entry terminal, the order specifying a plurality of recipients and, for each specified recipient, a set of one or more images associated with that recipient; transmitting the received order from the public entry terminal to a photo-finishing facility; for each of the plurality of recipients specified in the received order,

printing at the photo-finishing facility at least one copy of each image in the recipient's image set; and distributing the printed image copies to their respective associated recipients. See *In re Zurko*, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001).

Under *Vaeck*, absent any evidence of a cited suggestion or reasonable motivation in the Johnson reference, or knowledge of those skilled in the art to modify Fredlund to arrive at receiving a single order specifying a plurality of recipients and dividing the order into a plurality of sub-orders, each corresponding to a different recipient, *prima facie* obviousness of claims 127-131 has not been established. Moreover, the dependent claims were rejected with the conclusory statement "It would have been obvious to one of ordinary skill in the art at the time the invention was made" with reason created using hindsight. Such unsupported rejections are improper and must be withdrawn.

## SUMMARY

For the foregoing reasons, it is earnestly submitted that the Examiner's rejection is erroneous, that reversal of this decision is respectfully requested, and that all of the pending claims be allowed.

Respectfully submitted,



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**EXHIBIT A**  
**PENDING CLAIMS**

1           1. A computer-implemented method of distributing image prints to a plurality of  
2 recipients, the method comprising:  
3           receiving an order specifying a plurality of recipients and, for each specified recipient, a  
4 set of one or more images associated with that recipient;  
5           for each of the plurality of recipients specified in the received order, printing at least one  
6 copy of each image in the recipient's image set; and  
7           distributing the printed image copies to their respective associated recipients.

1           2. The method of claim 1 wherein images in a first recipient's image set differ from  
2 images in a second recipient's image set.

1           3. The method of claim 1 wherein print parameters of a first recipient's image set differ  
2 from printing parameters of a second recipient's image set.

1           4. The method of claim 3 wherein print parameters include one or more of print size,  
2 number of copies, print finish, and/or a textual message.

1           5. The method of claim 1 wherein print parameters differ among images within an image  
2 set.

1           6. The method of claim 5 wherein print parameters include one or more of print size,  
2 number of copies, print finish, and/or a textual message.

1           7. The method of claim 1 wherein each image set comprises an arbitrary grouping of  
2 images designated by a user.

1           8. The method of claim 1 wherein receiving, printing and distributing are performed by a  
2     single entity.

1           9. The method of claim 1 wherein the performance of receiving, printing and distributing  
2     is dispersed among two or more different entities.

1           10. The method of claim 1 wherein receiving an order is performed by an enterprise  
2     providing a web front-end.

1           11. The method of claim 10 wherein printing or distributing, or both, are performed by a  
2     fulfillment enterprise different than the enterprise providing the web front-end.

1           12. The method of claim 1 wherein printing and distributing are integrated processes.

1           13. The method of claim 1 wherein printing and distributing are performed by a single  
2     entity.

1           14. The method of claim 1 wherein printing and distributing are performed by different  
2     entities.

1           15. The method of claim 1 further comprising, prior to printing, dividing the received  
2     order into a plurality of sub-orders, each sub-order corresponding to a different recipient.

1           16. The method of claim 15 wherein printing comprises printing a set of one or more  
2     images in each sub-order.

1           17. The method of claim 15 wherein printing comprises, for each sub-order, printing a  
2     run of prints associated with a specified recipient.

1           18. The method of claim 17 further comprising printing a destination identifier that  
2 identifies the specified recipient for a corresponding run of prints.

1           19. The method of claim 18 wherein the destination identifier delimits a corresponding  
2 sub-order.

1           20. The method of claim 18 wherein printing the destination identifier comprises printing  
2 one or more of the following items: a shipping address, a recipient's name, a thumbnail image  
3 index, a bar code, a textual message and/or print re-ordering information.

1           21. The method of claim 18 wherein a first image in a sub-order has one or more print  
2 parameters that differ from one or more print parameters of a second image in the sub-order.

1           22. The method of claim 21 wherein print parameters include one or more of print size,  
2 number of copies, print finish, and/or a textual message.

1           23. The method of claim 15 wherein dividing the received order into the plurality of sub-  
2 orders comprises, for each image in the received order, instantiating a copy of the image for each  
3 recipient designated to receive a print of that image.

1           24. The method of claim 23 wherein an instantiated copy comprises a digital image file.

1           25. The method of claim 15 wherein dividing the received order into the plurality of sub-  
2 orders is performed by a first entity and printing the sub-orders is performed by a second entity.

1           26. The method of claim 25 wherein the first entity comprises a photo-finishing  
2 enterprise.

1           27. The method of claim 25 wherein the second entity comprises a goods / service  
2 provider enterprise.

1           28. The method of claim 25 wherein the second entity comprises a supermarket, a  
2 drugstore, a post office, or an online grocer.

1           29. The method of claim 25 wherein distributing the printed image copies comprises  
2 delivering a recipient's printed image copies along with an unrelated order of goods / services  
3 associated with that recipient.

1           30. The method of claim 1 wherein a recipient comprises an individual.

1           31. The method of claim 1 wherein a recipient comprises a business entity.

1           32. The method of claim 1 wherein a recipient comprises an address.

1           33. The method of claim 1 wherein the plurality of recipients comprises an individual, an  
2 address, a business entity, or any combination thereof.

1           34. The method of claim 1 wherein at least one of the specified recipients is different  
2 from a user from whom the order was received.

1           35. The method of claim 1 wherein the order comprises a single transaction sequence.

1           36. The method of claim 35 wherein the single transaction sequence comprises a single  
2 charge to a financial instrument.

1           37. The method of claim 36 wherein the financial instrument comprises a credit card, a  
2 debit card, electronic funds transfer, a gift certificate, or a coupon.

1           38. The method of claim 35 wherein the single transaction sequence is terminated by a  
2 click of an "order" button.

1           39. A computer-implemented method of distributing physical manifestations of digital  
2 content to a plurality of recipients, the method comprising:  
3           receiving an order specifying a plurality of recipients and, for each specified recipient, a  
4 set of digital content associated with that recipient;  
5           for each of the plurality of recipients specified in the received order, generating a  
6 physical manifestation of the digital content in the recipient's digital content set; and  
7           distributing the physical manifestations to their respective associated recipients.

1           40. The method of claim 39 wherein a set of digital content comprises one or more digital  
2 images.

1           41. The method of claim 40 wherein the physical manifestation of the set of digital  
2 content comprises photographic prints of the one or more digital images.

1           42. The method of claim 39 wherein the physical manifestation of digital content  
2 comprises a framed photographic print of a digital image.

1           43. The method of claim 39 wherein the physical manifestation of the set of digital  
2 content comprises photo-album pages bearing one or more digital images.

1           44. The method of claim 39 wherein the physical manifestation of the set of digital  
2 content comprises compositions of digital images and other graphical and/or textual content.

1           45. The method of claim 40 wherein the physical manifestation of the set of digital  
2 content comprises an artifact bearing a digital image.

1           46. The method of claim 45 wherein the artifact bearing a digital image comprises a  
2 novelty item.

1           47. The method of claim 45 wherein the artifact bearing the digital image comprises a  
2 shirt, a coffee mug, a key-chain, a mouse pad, a magnet, or a deck of playing cards.

1           48. The method of claim 39 wherein a set of digital content comprises graphical and/or  
2 textual content.

1           49. The method of claim 48 wherein the physical manifestation of the set of digital  
2 content comprises cards bearing the graphical and/or textual content.

1           50. The method of claim 49 wherein the cards bearing the graphical and/or textual  
2 content comprise one or more of the following: greeting cards, holiday cards, announcements,  
3 playing cards, post cards, thank you cards, or invitations.

1           51. The method of claim 48 wherein the physical manifestation of the set of digital  
2 content comprises cards bearing the graphical and/or textual content.

1           52. The method of claim 48 wherein the physical manifestation of the set of digital  
2 content comprises advertisements bearing the graphical and/or textual content.

1           53. The method of claim 48 wherein the physical manifestation of the set of digital  
2 content comprises coupons bearing the graphical and/or textual content.

1           54. The method of claim 48 wherein the physical manifestation of the set of digital  
2 content comprises a bound volume bearing the graphical and/or textual content.



1           55. The method of claim 54 wherein the bound volume comprises a photo-album.

1           56. The method of claim 54 wherein the bound volume comprises a travel book.

1           57. The method of claim 48 wherein the graphical and/or textual content comprises  
2 digital images and/or digitized content.

1           58. The method of claim 48 wherein the graphical and/or textual content comprises  
2 computer-generated content.

1           59. A computer-implemented method of distributing photographic prints to a plurality of  
2 recipients, the method comprising:

3           (a) receiving an order specifying:

4                 (i) a plurality of recipients;

5                 (ii) for each specified recipient, a set of one or more digital images associated  
6 with that recipient; and

7                 (iii) for each digital image, a set of one or more print parameters;

8           (b) dividing the received order into a plurality of sub-orders, each sub-order  
9 corresponding to a different specified recipient, each sub-order comprising an instance of each  
10 digital image associated with the recipient corresponding to the sub-order;

11           (c) printing the instantiated digital images in each of the sub-orders according to the print  
12 parameters associated with each image; and

13           (d) distributing the prints to their respective associated recipients.

1           60. The method of claim 59 wherein receiving an order comprises receiving interactive  
2 input from a user of a computer system.

1           61. The method of claim 60 wherein the computer system comprises the user's personal  
2 computer system.

1           62. The method of claim 60 wherein the computer system comprises a public entry  
2 terminal.

1           63. The method of claim 59 wherein the print parameters include one or more of print  
2 size, number of copies, print finish, and/or a textual message.

1           64. The method of claim 59 wherein printing and distributing are integrated processes.

1           65. The method of claim 59 wherein receiving, dividing, printing and distributing are  
2 performed by a single entity.

1           66. The method of claim 59 wherein the performance of receiving, dividing, printing and  
2 distributing is dispersed among two or more different entities.

1           67. The method of claim 59 wherein receiving an order is performed by an enterprise  
2 providing a web front-end.

1           68. The method of claim 67 wherein one or more of dividing, printing and distributing  
2 are performed by a fulfillment enterprise different than the enterprise providing the web front-  
3 end.

1           69. The method of claim 59 wherein printing and distributing are performed by a single  
2 entity.

1           70. The method of claim 59 wherein printing and distributing are performed by different  
2 entities.

1           71. The method of claim 59 further comprising printing a destination identifier that  
2 identifies the specified recipient for a corresponding sub-order.

1           72. The method of claim 71 wherein the destination identifier delimits a corresponding  
2 sub-order.

1           73. The method of claim 71 wherein printing the destination identifier comprises printing  
2 one or more of the following items: a shipping address, a recipient's name, a thumbnail image  
3 index, a bar code, a textual message and/or print re-ordering information.

1           74. The method of claim 59 wherein a first image in a sub-order has print parameters that  
2 differ from print parameters of a second image in the sub-order.

1           75. The method of claim 59 wherein dividing the received order into the plurality of sub-  
2 orders is performed by a first entity and printing the sub-orders is performed by a second entity.

1           76. The method of claim 75 wherein the first entity comprises a photo-finishing  
2 enterprise.

1           77. The method of claim 75 wherein the second entity comprises a goods / service  
2 provider enterprise.

1           78. The method of claim 77 wherein the second entity comprises a supermarket, a  
2 drugstore, a post office, or an online grocer.

1           79. The method of claim 59 wherein distributing the prints comprises delivering a  
2 recipient's prints along with an unrelated order of goods / services associated with that recipient

1           80. A print distribution system comprising:

2 a front-end computer sub-system for receiving an order specifying a plurality of  
3 recipients and, for each specified recipient, a set of one or more images associated with that  
4 recipient;  
5 a printing sub-system for printing at least one copy of each image in each recipient's  
6 image set; and  
7 a distribution sub-system for distributing the printed image copies to their respective  
8 associated recipients.

1 81. The system of claim 80 wherein images in a first recipient's image set differ from  
2 images in a second recipient's image set.

1 82. The system of claim 80 wherein print parameters of a first recipient's image set differ  
2 from printing parameters of a second recipient's image set.

1 83. The system of claim 82 wherein print parameters include one or more of print size,  
2 number of copies, print finish, and/or a textual message.

1 84. The system of claim 80 wherein print parameters differ among images within an  
2 image set.

1 85. The system of claim 84 wherein print parameters include one or more of print size,  
2 number of copies, print finish, and/or a textual message.

1 86. The system of claim 80 wherein each image set comprises an arbitrary grouping of  
2 images designated by a user that placed the order.

1 87. The system of claim 80 wherein the front-end computer sub-system, the printing sub-  
2 system and the distribution sub-system are controlled by a single entity.

1           88. The system of claim 80 wherein the front-end computer sub-system, the printing sub-  
2 system, and the distribution sub-system are dispersed among two or more different entities.

1           89. The system of claim 80 wherein the front-end computer sub-system is controlled by  
2 an enterprise providing a web front-end.

1           90. The system of claim 89 wherein the printing sub-system or the distribution sub-  
2 system, or both, are controlled by a fulfillment enterprise different than the enterprise providing  
3 the web front-end.

1           91. The system of claim 80 wherein the printing sub-system and the distribution sub-  
2 system are integrated.

1           92. The system of claim 80 wherein the printing sub-system and the distribution sub-  
2 system are controlled by a same entity.

1           93. The system of claim 80 wherein the printing sub-system and the distribution sub-  
2 system are controlled by different entities.

1           94. The system of claim 80 wherein the printing sub-system comprises a sub-system for  
2 dividing the received order into a plurality of sub-orders, each sub-order corresponding to a  
3 different recipient.

1           95. The system of claim 94 wherein the printing sub-system prints a set of one or more  
2 images in each sub-order.

1           96. The system of claim 94 wherein, for each sub-order, the printing sub-system prints a  
2 run of prints associated with a specified recipient.

1           97. The system of claim 96 wherein the printing sub-system further prints a destination  
2 identifier that identifies the specified recipient for a corresponding run of prints.

1           98. The system of claim 97 wherein the destination identifier delimits a corresponding  
2 sub-order.

1           99. The system of claim 97 wherein printing the destination identifier comprises printing  
2 one or more of the following items: a shipping address, a recipient's name, a thumbnail image  
3 index, a bar code, a textual message and/or print re-ordering information.

1           100. The system of claim 94 wherein dividing the received order into the plurality of sub-  
2 orders comprises, for each image in the received order, instantiating a copy of the image for each  
3 recipient designated to receive a print of that image.

1           101. The system of claim 100 wherein an instantiated copy comprises a digital image file.

1           102. The system of claim 94 wherein dividing the received order into the plurality of sub-  
2 orders is performed by a first entity and printing the sub-orders is performed by a second entity.

1           103. The system of claim 102 wherein the first entity comprises a photo-finishing  
2 enterprise.

1           104. The system of claim 102 wherein the second entity comprises a goods / service  
2 provider enterprise.

1           105. The system of claim 104 wherein the second entity comprises a supermarket, a  
2 drugstore, a post office, or an online grocer.

1           106. The system of claim 104 wherein distributing the printed image copies comprises  
2 delivering a recipient's printed image copies along with an unrelated order of goods / services  
3 associated with that recipient.

1           107. The system of claim 80 wherein a recipient comprises an individual.

1           108. The system of claim 80 wherein a recipient comprises a business entity.

1           109. The system of claim 80 wherein a recipient comprises an address.

1           110. The system of claim 80 wherein the plurality of recipients comprises an individual,  
2 an address, a business entity, or any combination thereof.

1           111. The system of claim 80 wherein at least one of the specified recipients is different  
2 from a user from whom the order was received.

1           112. The system of claim 80 wherein the order received by the front-end computer  
2 system comprises a single transaction sequence.

1           113. The system of claim 112 wherein the single transaction sequence comprises a single  
2 charge to a financial instrument.

1           114. The system of claim 113 wherein the financial instrument comprises a credit card, a  
2 debit card, electronic funds transfer, a gift certificate, or a coupon.

1           115. The system of claim 112 wherein the single transaction sequence is terminated by a  
2 click of an "order" button

1           116. A computer-implemented method of distributing image prints to a plurality of  
2 recipients, the method comprising:  
3           receiving, at a facility corresponding to a first entity, an order specifying a plurality of  
4 recipients and, for each specified recipient, a set of one or more images associated with that  
5 recipient;  
6           communicating the received order to a facility corresponding to a second entity;  
7           at the second entity's facility, for each of the plurality of recipients specified in the  
8 received order, printing at least one copy of each image in the recipient's image set; and  
9           distributing the printed image copies to their respective associated recipients.

1           117. The method of claim 116 wherein the first entity comprises a photo-finishing  
2 enterprise.

1           118. The method of claim 116 wherein the second entity comprises a goods / service  
2 provider enterprise.

1           119. The method of claim 118 wherein the second entity comprises a supermarket, a  
2 drugstore, a post office, or an online grocer.

1           120. The method of claim 118 wherein distributing the printed image copies comprises  
2 delivering a recipient's printed image copies along with an unrelated order of goods / services  
3 associated with that recipient.

1           121. The method of claim 116 wherein, prior to communicating the received order to the  
2 facility corresponding to the second entity, the first entity divides the received order into a  
3 plurality of sub-orders, each sub-order corresponding to a different recipient.

1           122. The method of claim 121 wherein printing comprises printing a set of one or more  
2 images in each sub-order.



1           123. The method of claim 121 wherein printing comprises, for each sub-order, printing a  
2 run of prints associated with a specified recipient.

1           124. The method of claim 123 further comprising printing a destination identifier that  
2 identifies the specified recipient for a corresponding run of prints.

1           125. The method of claim 124 wherein the destination identifier delimits a corresponding  
2 sub-order.

1           126. The method of claim 124 wherein printing the destination identifier comprises  
2 printing one or more of the following items: a shipping address, a recipient's name, a thumbnail  
3 image index, a bar code, a textual message and/or print re-ordering information.

1           127. A computer-implemented method of distributing image prints to a plurality of  
2 recipients, the method comprising:

3           receiving an order from a user at a public entry terminal, the order specifying a plurality  
4 of recipients and, for each specified recipient, a set of one or more images associated with that  
5 recipient;

6           transmitting the received order from the public entry terminal to a photo-finishing  
7 facility;

8           for each of the plurality of recipients specified in the received order, printing at the photo-  
9 finishing facility at least one copy of each image in the recipient's image set; and

10          distributing the printed image copies to their respective associated recipients.

1           128. The method of claim 127 wherein receiving the order from the user at the public  
2 entry terminal comprises reading digital images from a computer-readable medium provided to  
3 the public-entry terminal.

1           129. The method of claim 128 wherein the computer-readable medium comprises a  
2 FLASH memory, a CD-ROM or a diskette.

1           130. The method of claim 127 wherein receiving the order from the user at the public  
2 entry terminal comprises receiving manual input specifying the plurality of recipients and the set  
3 of one or more images associated with each recipient.

1           131. The method of claim 127 wherein the public entry terminal comprises a digital drop  
2 box, a point-of-sale station, or a kiosk.

1           132. A computer-implemented method of ordering image prints for a plurality of  
2 recipients, the method comprising receiving at a host system an order from a client system, the  
3 order corresponding to a single transaction sequence and specifying a plurality of recipients and,  
4 for each specified recipient, a set of one or more images associated with that recipient.

1           133. The method of claim 132 further comprising, at the host system, dividing the  
2 received order into a plurality of sub-orders, each sub-order corresponding to a different  
3 recipient.

1           134. The method of claim 133 further comprising printing a set of one or more images in  
2 each sub-order.

1           135. The method of claim 133 wherein further comprising, for each sub-order, printing a  
2 run of prints associated with a specified recipient.

1           136. The method of claim 135 further comprising printing a destination identifier that  
2 identifies the specified recipient for a corresponding run of prints.

1           137. The method of claim 136 wherein the destination identifier delimits a corresponding  
2 sub-order.

1           138. The method of claim 136 wherein printing the destination identifier comprises  
2 printing one or more of the following items: a shipping address, a recipient's name, a thumbnail  
3 image index, a bar code, a textual message and/or print re-ordering information.

1           139. The method of claim 133 wherein a first image in a sub-order has print parameters  
2 that differ from print parameters of a second image in the sub-order.

1           140. The method of claim 139 wherein print parameters include one or more of print size,  
2 number of copies, print finish, and/or a textual message.

1           141. The method of claim 133 wherein dividing the received order into the plurality of  
2 sub-orders comprises, for each image in the received order, instantiating a copy of the image for  
3 each recipient designated to receive a print of that image.

1           142. The method of claim 141 wherein an instantiated copy comprises a digital image  
2 file.

1           143. The method of claim 132 wherein images in a first recipient's image set differ from  
2 images in a second recipient's image set.

1           144. The method of claim 132 wherein print parameters of a first recipient's image set  
2 differ from printing parameters of a second recipient's image set.

1           145. The method of claim 144 wherein print parameters include one or more of print size,  
2 number of copies, print finish, and/or a textual message.

1           146. The method of claim 132 wherein print parameters differ among images within an  
2 image set.

1           147. A computer-implemented method of processing an order for a physical  
2 manifestation of digital content, the method comprising:  
3           receiving an order specifying a plurality of recipients and, for each specified recipient, a  
4 set of digital content associated with that recipient;  
5           dividing the received order into a plurality of sub-orders, each sub-order corresponding to  
6 a different recipient, by instantiating a digital copy of the digital content for each recipient  
7 designated to receive a physical manifestation of that digital content; and  
8           generating a physical manifestation of the digital content in the recipient's digital content  
9 set.

1           148. The method of claim 147 wherein the digital content comprises a digital image and  
2 the physical manifestation comprises a photographic print of the digital image.

1           149. The method of claim 147 further comprising distributing the physical manifestations  
2 to their respective associated recipients.

1           150. The method of claim 147 wherein the receiving and dividing are performed by a first  
2 entity and the generating is performed by a second entity.

1           151. The method of claim 150 wherein the first entity comprises a photo-finishing  
2 enterprise and the second entity comprises a goods / service-provider enterprise.

1           152. The method of claim 147 wherein receiving, dividing and generating are performed  
2 by a single entity.

1           153. The method of claim 147 wherein the performance of receiving, dividing and  
2     generating is dispersed among two or more different entities.

1           154. The method of claim 147 wherein receiving an order is performed by an enterprise  
2     providing a web front-end.

1           155. The method of claim 154 wherein dividing or generating, or both, are performed by  
2     a fulfillment enterprise different than the enterprise providing the web front-end.